



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,396	02/04/2004	Byoung-Yue Kim	1793.1062	2743
21171 7590 02/29/2008 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER KAU, STEVEN Y	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 02/29/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/770,396

Applicant(s)

KIM, BYOUNG-YUE

Examiner

Steven Kau

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/25/05 & 10/21/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statements (IDS) submitted on May 25, 2005 and October 21, 2005 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application NO. 10-2003-0007434 on February 4, 2004.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 7-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention

Regarding claim 7, recites, " an address receiving portion which the transmitted network address " renders the claim indefinite because it is unclear whether the address receiving portion receives or transmits a network address. In light of the specification,

Par. 0044 of the disclosure, this claim limitation is interpreted as "the address receiving portion 130 receives the network address that is transmitted".

Claims 8-12 are rejected under 35 U.S.C. 112, second paragraph, for the same reasons discussed in this section of claim 7 rejection under 35 U.S.C. 112, second paragraph.

See MPEP § 2173.05(d).

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5, 7-11 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Mochizuki (US 7,113,298).

Regarding claim 7.

Mochizuki discloses an apparatus (Host 10 of Fig. 1) for printing data using an identification number of a printer (e.g. Printer ID, col 7, lines 40-42) to perform a printing process through a network in which a plurality of printers are respectively connected to a plurality of computers (Fig. 1), comprising: a port (e.g. port 30 of Fig. 7, col 5, line 59 through col 6, line 22) setting portion (e.g. printer retrieval unit 48 of Fig. 7) which

Art Unit: 2625

requests the printers to transmit identification numbers in response to a printer port set request (Fig. 9 teaches printer retrieval with an identifier indicative of a request from printer by Host 10, col 6, lines 7-57) and which stores the received identification numbers (e.g. retrieved printer information, including printer identifier and IP address is stored as part of Driver 25 of Fig. 7, and therefore, this information can be displayed as a GUI posting to the operator, col 7, lines 40-55); an identification number transmitting portion (printer retrieval responding unit 56 of Fig. 8) which transmits the requested identification numbers (col 8, line 53 through col 9, line 8); a request signal generating portion (Printer retrieval packet of Fig. 9 & print request packet of Fig. 11) which generates an address request signal requesting a network address (printer IP address) of a specific printer among the printers in response to a print request (col 6, lines 10-57 & col 7, lines 5-32) and which outputs the generated address request signal (Figs. 7 and 8, col 6, lines 7-57); an address transmitting portion (response packet from printer of Fig. 10) which transmits the network address in response to the address request signal (col 6, lines 38-57); an address receiving portion (Printer Retrieval Unit 48 of Fig. 7 & Step 9 of Fig. 13, col 7, line 56 through col 8, line 8) which the transmitted network address (col 6, lines 48-64); a data transmitting portion (Application 16 & port 30 of Fig. 7) which transmits print data to the specific printer (Figs. 14a-b, & Figs 15a-b, col 10, line 51 through col 11, line 6); and a print portion which prints the transmitted print data ("host posts the print data transfer unit 52 to start the printing processing in step S18", col 10, lines 51-67, one of skilled in the art understands that printer prints out the transmitted print data).

Regarding claim 1.

Claim 1 recites identical features as claim 7, except claim 1 is a method claim.

Thus, arguments similar to that presented above for claim 7 are also equally applicable to claim 1.

Regarding claim 13.

Claim 13 recites identical features as claim 7, except claim 13 is a method claim.

Thus, arguments similar to that presented above for claim 7 are also equally applicable to claim 13.

Regarding claim 8.

Mochizuki discloses wherein the address request signal includes an identification number corresponding to the specific printer (e.g. a printer IP address and port number, col 6, lines 50-53).

Regarding claim 9.

Mochizuki discloses an identification number checking portion (response packet from printer of Fig. 10) checking (judging) whether an identification number of a printer having the address transmitting portion and the predetermined identification number are the same, in response to the address request signal having the predetermined identification number, and outputting (unicast) the result of check as a check signal (Fig. 13, col 7, line 56 through col 8, line 27); and a transmission portion transmitting (unicast) the network address (IP address) of the predetermined printer having the same identification number in response to the check signal (Fig. 13, col 7, line 56 through col 8, line 27, and Figs 15a-b, col 8, line 53 through col 9, line 8).

Regarding claim 10.

Mochizuki discloses wherein the network address is one of an Internet protocol (IP) address, an Internet packet exchange (IPX) address, and a media access control (MAC) address (col 6, lines 50-57).

Regarding claim 11.

Mochizuki discloses the identification numbers are printer port registration information (col 6, lines 50-57).

Regarding claim 2.

Claim 2 recites identical features as claim 9, except claim 2 is a method claim. Thus, arguments similar to that presented above for claim 9 are also equally applicable to claim 2.

Regarding claim 3.

Claim 3 recites identical features as claim 10, except claim 3 is a method claim. Thus, arguments similar to that presented above for claim 10 are also equally applicable to claim 3.

Regarding claim 4.

Claim 4 recites identical features as claim 8, except claim 4 is a method claim. Thus, arguments similar to that presented above for claim 8 are also equally applicable to claim 4.

Regarding claim 5.

Claim 5 recites identical features as claim 11, except claim 5 is a method claim. Thus, arguments similar to that presented above for claim 11 are also equally applicable to claim 5.

Regarding claim 14.

Claim 14 recites identical features as claim 8, except claim 14 is a method claim. Thus, arguments similar to that presented above for claim 8 are also equally applicable to claim 14.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mochizuki (US 7,113,298) as applied to claims 1 and 7 above, and in view of Motoyama et al (Motoyama) (US 6,839,717).

Regarding claim 12.

Mochizuki differs from claim 12, in that he does not expressly teach wherein the identification numbers are printer serial numbers, but Mochizuki teaches using print's name as printer identifier in network printing (col 7, lines 45-50).



Art Unit: 2625

Motoyama teaches wherein the identification numbers are printer serial numbers (col 32, lines 7-34).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Mochizuki to include wherein the identification numbers are printer serial numbers, but Mochizuki teaches using print's name as printer identifier in network printing taught by Motoyama to a flexible, quick and easy way to determine or identify a device for communication (col 4, lines 10-52).

Regarding claim 6.

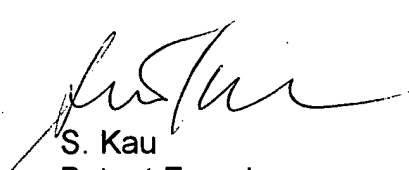
Claim 6 recites identical features as claim 12, except claim 6 is a method claim. Thus, arguments similar to that presented above for claim 12 are also equally applicable to claim 6.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Kau whose telephone number is 571-270-1120 and fax number is 571-270-2120. The examiner can normally be reached on M-F, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on 571-272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Kau  
Patent Examiner  
Division: 2625  
February 25, 2008



GABRIEL GARCIA  
PRIMARY EXAMINER